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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,149	11/30/2001	Hideo Neishi	09812.0578-00000	4641
22852 7590 10/12/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER KHATTAR, RAJESH	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 10/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/998,149

Applicant(s)

NEISHI ET AL.

Examiner

Rajesh Khattar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 4, 13, 20 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-12, 14-19, 21-23, 25-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

This Office Action is in response to Applicant's communication filed on July 26, 2007. Claims 1, 10 and 21 have been amended. Claims 4, 13, 20 and 24 have been cancelled previously. As such, claims 1-3, 5-12, 14-19, 21-23 and 25-29 remain pending in this application.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 26, 2007 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-12, 14-23 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al., US Patent No. 6,249,281 in view of Jeyachandran et al., US Patent No. 6,633,871 and further in view of Thiel, US Patent No. 5,606,508. Chen teaches a comprehensive system for producing and distributing on-demand

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presentations over a network (col. 1, lines 19-20). Chen teaches that elements of the presentation invention are included within a client-server system in which one or more presentation servers communicate with one or more clients. The clients transmit and receive data from the presentation servers over a variety of communication channel including local area networks or the Internet (col. 2, lines 40-55) (The clients of Chen represent the presenter and the reader; the presentation servers represents the presentation material publishing server which is accessed by the clients/presenter/reader via a network).

Chen teaches implementing various types of business methods using the presentation system. In particular organizations may pay a one-time fee for the service and then end users or employees would not be charged to view the presentations. In another embodiment taught by Chen end users would access the presentation on a pay-per-view basis (col. 6, line 53 – column 7, line 20) (performing a credit process prior to uploading presentation material). Chen teaches charging a fee to view over a specified period (col. 7, lines 5-6) (public information contains publication period). Chen further teaches maintaining a searchable database of on-demand presentations on the presentation server, in which stored presentations are categorized in an index, allowing users to search for a presentation on a particular topic (col. 5, lines 22-30).

Chen teaches an example of a user purchasing the right to view a particular presentation that identification information is stored on the computer in the form of a token or cookie (col. 7, lines 42-53). Examiner notes that this corresponds to a

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membership registration means for registering for authorized access to presentation material publishing server.

Examiner notes that it is inherent to the system of Chen that public information (defined by applicant on page 25; paragraph 2 of the specification as the presentation time of the materials, category information and downloading permission information") be collected, as it is necessarily required to collect this information (such as category or permission data) in order to know how to charge the user to view the presentation and to allow the user to search by category. (User registration of a presenter is performed; public information contains at least category or browsing permissions). Additionally, Examiner notes that it is inherent and necessarily present in the invention of Chen that the target address is notified to the presenter/client only after uploading is permitted, as it would make no sense to provide that address if the uploading were not permitted.

Chen further teaches different embodiments in which the users of the system pay fees for downloading (col. 6, line 53 – col. 7, line 6). Examiner notes specifically that a percentage of a fee paid for downloading paid to the content owner and the ODPO represents a download condition that is enter or negotiated by the content owner or presenter.

Chen further teaches "presentation content owner will pay ODPO to produce and/or host on-demand presentation." Examiner notes that this clearly teaches that the servers of Chen store the data for some amount of time. However Chen does not specifically teach a "publication period" representing the period by which the presentation materials are active for downloading by the reader.

Jeyachandran teaches a method for publication of information for a period of time (col. 29, lines 45-67; i.e. publication period). Jeyachandran also discloses wherein the publication period is selected from a plurality of different initial publication periods (col. 29, lines 45-67). In addition to this, Jeyachandran also disclosing downloading feature (col. 1, lines 45-col. 2, lines 45). Although, Jeyachandran does not specifically states that the publication period indicating a period during which said presentation materials are available for downloading, However, arguments can be made that one of ordinary skilled in the art at the time the invention was made would have modified the disclosure of Jeyachandran to include downloading during the publication period. To add further support, Examiner cites Thiel as an additional reference that teaches stored data to be downloaded for only a limited period of time (col. 3, lines 27-33, Examiner interprets limited period of time to be equivalent to Applicant's publication period).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the disclosures of Chen to include the disclosures of Jeyachandran and Thiel. One would have been motivated to do so in order to limit the publication period as illustrated by Jeyachandran.

Alternatively, claims 1-3, 5-12, 14-23 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Richardson, US Patent Application Publication Number 2002/0022962 and further in view of Thiel and Jeyachandran.

Chen teaches a comprehensive system for producing and distributing on-demand presentations over a network (col. 1, lines 19-20). Chen teaches that elements of the presentation invention are included within a client-server system in

which one or more presentation servers communicate with one or more clients. The clients transmit and receive data from the presentation servers over a variety of communication channel including local area networks or the Internet (col. 2, lines 40-55) (The clients of Chen represent the presenter and the reader; the presentation servers represents the presentation material publishing server which is accessed by the clients/presenter/reader via a network).

Chen teaches implementing various types of business methods using the presentation system. In particular organizations may pay a one-time fee for the service and then end users or employees would not be charged to view the presentations. In another embodiment taught by Chen end users would access the presentation on a pay-per-view basis (col. 6, line 53 – column 7, line 20) (performing a credit process prior to uploading presentation material). Chen teaches charging a fee to view over a specified period (col. 7, lines 5-6) (public information contains publication period). Chen further teaches maintaining a searchable database of on-demand presentations on the presentation server, in which stored presentations are categorized in an index, allowing users to search for a presentation on a particular topic (col. 5, lines 22-30).

Chen teaches an example of a user purchasing the right to view a particular presentation that identification information is stored on the computer in the form of a token or cookie (col. 7, lines 42-53). Examiner notes that this corresponds to a membership registration means for registering for authorized access to presentation material publishing server.

Examiner notes that it is inherent to the system of Chen that public information (defined by applicant on page 25; paragraph 2 of the specification as the presentation time of the materials, category information and downloading permission information”) be collected, as it is necessarily required to collect this information (such as category or permission data) in order to know how to charge the user to view the presentation and to allow the user to search by category. (User registration of a presenter is performed; public information contains at least category or browsing permissions). Additionally, Examiner notes that it is inherent and necessarily present in the invention of Chen that the target address is notified to the presenter/client only after uploading is permitted, as it would make no sense to provide that address if the uploading were not permitted.

Chen further teaches different embodiments in which the users of the system pay fees for downloading (col. 6, line 53 – col. 7, line 6). Examiner notes specifically that a percentage of a fee paid for downloading paid to the content owner and the ODPO represents a download condition that is enter or negotiated by the content owner or presenter.

Chen further teaches “presentation content owner will pay ODPO to produce and/or host on-demand presentation.” Examiner notes that this clearly teaches that the servers of Chen store the data for some amount of time. However Chen does not specifically teach a “publication period” representing the period by which the presentation materials are active for downloading by the reader.

Richardson teaches a method for maintaining a website. Specifically, Richardson teaches the posting of the website for a predetermined period and after the



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predetermined period deactivating the website (see for example paragraphs 0025, 0075, 0078 and 0087). Richardson teaches deactivation is useful in order to help receive compensation.

It is Examiner's position that Chen teaches downloading and combining Chen with Richardson would be equivalent to the Applicant's limitation of claim 1 in particular "the publication period indicating a period during which said presentation materials are available for downloading from the presentation material publishing server". However, to add further support, Examiner cites Thiel as an additional reference that teaches stored data to be downloaded for only a limited period of time (col. 3, lines 27-33, Examiner interprets limited period of time to be equivalent to Applicant's publication period).

Moreover, Chen, Richardson and Thiel fail to specifically disclose wherein the publication period is selected from a plurality of different initial publication periods. However, Jeyachandran discloses this feature (col. 29, lines 45-67).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the interaction between the ODPO and the content owners of Chen to include a publication period as taught by Richardson, downloading feature during the publication period as taught by Thiel and the publication period is selected from a plurality of different initial publication periods as taught by Jeyachandran in order to help to ODPO receive compensation for their hosting services.

***Response to Arguments***

Examiner has withdrawn the rejection of claims 1-3, 5-12, 14-19, 21-23 and 25-29 under 35 USC § 112, first paragraph, as Applicant's amendment (dated Dec. 20, 2006) has addressed the issue.

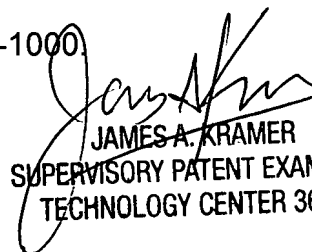
Applicant's arguments with respect to pending claims under 35 U.S.C. § 103(a) have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rajesh Khattar whose telephone number is 571-272-7981. The examiner can normally be reached on Flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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